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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,728	01/23/2004	Thomas J. Berwald	0092-18 CIP	7328

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EXAMINER

TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,728

Applicant(s)

BERWALD ET AL.

Examiner

A. Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 1-19, 22-31, 33, 48, 49 and 54-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20, 21, 32 and 34-38 is/are rejected.
- 7) ☒ Claim(s) 39-47 and 50-53 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/23/04, 1/16/04, 11/26/04, 9/2/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the invention of Group III-D, Claims 35 through 47 and 50 through 53 in the reply filed on August 28, 2006 is acknowledged.

NOTE: Claims 48 and 49 in the previous Office Action, was inadvertently omitted from Group III-E, as Claims 48 and 49 should have been grouped with the invention of Group III-E.

The traversal is on the ground(s) that the searches for all of Groups I, II and III would be co-extensive and would overlap in scope, therefore, the restriction requirement should be withdrawn as there would be burden to search for all of the inventions

This is not found persuasive because as noted in the previous Office Action, the different groups of inventions do not overlap in scope. While the applicant(s) are correct to point out that each of the Groups recited some similar features, it is the features that are not similar that has invoked the restriction requirement.

For example, the applicant(s) note that all of the groups require an adhesive. However, not all adhesives require curing or heat treatment thermal processing. So an adhesive of the invention of Group I can be one that can bonds the materials with no curing and no thermal processing. With respect to the inventions of Groups II and III, the applicant(s) note that both groups require winding a soft magnetic material. However, the process of milling required in Group III is nowhere to found in Group II. With respect to Groups III-A through III-E, the features are mutually exclusive each having completely different manufacturing effects. For example, the atmospheric soak process of Group III-A is nowhere to found in Groups III-B through III-E. So the examiner notes that it is the dissimilar features within each group that

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requires different lines of patentability, non-coextensive searches, the application of various different art, and even the application of different case law. After taking all of the factors into consideration, this would place a serious burden on the examiner to search and examine all of the inventions.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1 through 19, 22 through 31, 33, 48, 49 and 54 through 59 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 28, 2006.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: --A Process of Manufacturing a Soft Magnetic Metal Electro-Mechanical Component--.

4. The disclosure is objected to because of the following informalities: on page 1, the phrase of "U.S. Patent" (line 3) is incomplete.

Appropriate correction is required.

Double Patenting

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 20 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 20 of copending Application No. 10/876,034.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all of the steps and elements of Claim 20 of the instant application are found in Claim 20 of the copending application. The difference between Claim 20 of the instant application and Claim 20 of the copending application is that Claim 20 of the copending application contains one more step of applying a magnetic field to the torroid, thus Claim 20 of the copending application is much more specific. Therefore, Claim 20 of the copending application is in effect a “species” of the “generic” invention of the instant application. It has been held that the generic invention is “anticipated” by the “species” *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since Claim 20 of the instant application is anticipated by

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Claim 20 of the copending application, Claim 20 of the instant application is not patentably distinct from Claim 20 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by GB patent publication GB 597218, referred to hereinafter as GB'218.

GB'218 discloses a method comprising: winding a soft magnetic material ribbon (e.g. 22) into a torroid (see Fig. 2); containing the torroid with a torroidal geometry; milling the torroid into an electro-mechanical component shape (page 3, lines 124-130); and thermally processing the component shape into a electro-mechanical component by heating (page 4, lines 39+).

10. Claims 20, 21, 32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Decristofaro et al 6,803,694.

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Decristofaro discloses a method comprising: winding a soft magnetic material ribbon into a torroid and containing the torroid with a torroidal geometry(col. 12, lines 54-60); milling the toroid into an electro-mechanical component shape (col. 14, lines 15+); and thermally processing the component shape into a electro-mechanical component by heating (col. 13, lines 23+).

Regarding Claim(s) 21, 32 and 34, Decristofaro further teaches applying an adhesive and curing the adhesive (col. 13, lines 50-60).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 35 through 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decristofaro et al in view of Villano Re. 28,559.

Decristofaro discloses a method as relied upon above in Claims 32 and 34. Decristofaro does not mention that the milling assembly includes either one of: “an inner ring”, “an outer ring”, “a hat”, or “a base”, as alternatively claimed.

Villano teaches a process that includes a milling assembly that includes a work support (e.g. 40, 133, 128). This work support can broadly be read alternatively as either one of “an inner ring”, “an outer ring”, “a hat”, or “a base”, to mill radial slots within the a torroid (e.g. circular member).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Decristofaro by adding either one of “an inner ring”, “an outer ring”, “a hat”, or “a base”, as taught by the work support of Villano, to positively mill the torroid.

Allowable Subject Matter

13. Claims 39 through 47 and 50 through 53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

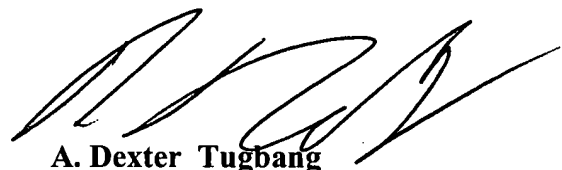
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 571-272-4570.

The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



A. Dexter Tugbang
Primary Examiner
Art Unit 3729

November 13, 2006